

7/07/12

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Mail Stop Petition

Commissioner for Patents

PO Box 1450

Alexandria VA 22313-1450

Re: Petition for Expired patent #6010468 under 37CFR 1.378

Application # 09/035,136

RECEIVED

JUL 16 2012

OFFICE OF PETITIONS

Dear Commissioner:

I am the inventor and patentee of the above patent. I entered an exclusive licensing agreement with a company called The Discovery Group. This company was to maintain patent maintenance fees or notify me of their failure to do so. They did neither, which I have now discovered (I do not know when the patent formally expired). This was an unavoidable delay and I would like to continue to try to bring this device to market as I believe it can help my patients. I sincerely appreciate your review in this matter. I have enclosed the page from the above mentioned licensing agreement that stipulates the responsibility of the company I granted exclusivity to. This agreement has now ended and I desire to continue. I would, as the inventor, maintain the patent and am willing to pay any backdated fees or penalties.

The co-inventor has assigned his rights of 'know how' to me.

Sincerely,

Lucian Grove MD

2516 Wycliffe Ave Roanoke VA 24014

540-521-9595

This Patent Image Provided By USPTO



US006010468A

United States Patent [19]

[11] Patent Number: 6,010,468

Grove et al.

[45] Date of Patent: Jan. 4, 2000

[54] FOOT FLEXION DEVICE

[75] Inventors: Lucian Yates Grove, Roanoke;
Richard John Freer, Richmond, both
of Va.

[73] Assignee: The Discovery Group, LLC,
Richmond, Va.

[21] Appl. No.: 09/035,136

[22] Filed: Mar. 5, 1998

[51] Int. Cl.⁷ A61B 5/11

[52] U.S. Cl. 601/23; 601/27

[58] Field of Search 601/23, 27, 11

References Cited

U.S. PATENT DOCUMENTS

3,370,584	2/1968	Girten .	
3,695,255	10/1972	Rodgers et al. .	
4,003,374	1/1977	Mizrachy .	
4,795,148	1/1989	Rungawamy .	
4,842,265	6/1989	Kirk .	
5,112,296	5/1992	Beard	602/28
5,293,755	3/1994	Thomas .	
5,713,370	2/1998	Cook	482/115
5,807,234	9/1998	Bui et al.	600/17

OTHER PUBLICATIONS

Practical Electromyography, edited by E.W.Johnson, M.D. and W.S. Pease, M.D.; (Third Edition—Williams & Wilkins, pp. 1-3, 63-87.

Practical Aspects of Venous Thromboembolism Prevention An Overview, Goldhaber, Samuel Z.; CVR & R (Dec. 1994).

Primary Examiner—Glenn E. Richman

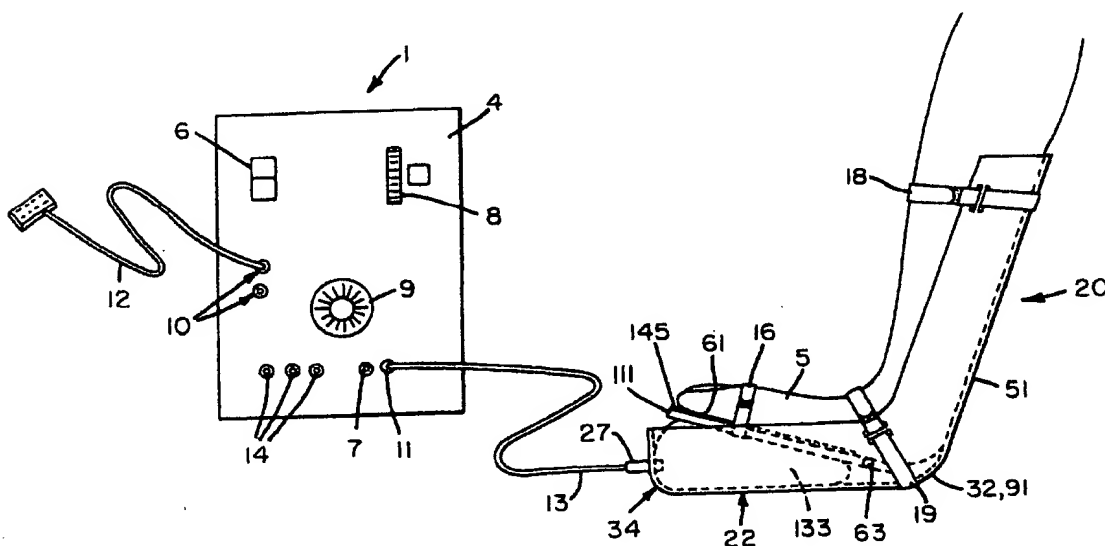
Attorney, Agent, or Firm—Venable; Gary L. Shaffer

[57]

ABSTRACT

A foot dorsiflexion device comprises at least one portable boot, which can be submersed in liquids if desired, worn by a patient, having a baseplate and a footplate affixed at one end to the baseplate. An inflatable bellows is positioned between the baseplate and footplate, such that inflating the bellows moves the footplate relative to the baseplate to effect flexion of the patient's foot. A controller controls the pumping sequence of a pump which can inflate one or more boot devices. In another feature, the controller also receives information as to the patient's leg muscle activity and responds appropriately to stop/re-start the device. Such a feedback mechanism is useful to prevent flexion during an abnormal contraction pattern, such as occurs in muscle spasm or tetany. The device is can be operated remotely and in both automatic and manual modes by the user or operator.

35 Claims, 5 Drawing Sheets



LICENSE AGREEMENT

THIS LICENSE AGREEMENT (the "Agreement") is made and effective as of May 20 1997, ~~1996~~ (the "Effective Date"), by and between Lucian Y. Grove, Jr., M.D., F.A.C.P. ("Licensor") and Discovery Group, L.C., a Virginia limited liability company the ("Company" or "Licensee").

RECITALS

A. The Licensor is the owner of rights in certain Technology and Licensed Patent Rights, as defined below, which in part have been developed and enhanced in cooperation with Richard J. Freer ("Freer"), a principal of the Company.

B. The Company desires to obtain a license to practice, develop, use and commercialize the Technology and the Licensed Patent Rights and to make, have made, use and sell Products (as such terms are defined below).

C. Licensor is willing to grant such license to the Company on the following terms and conditions.

NOW, THEREFORE, for and in consideration of the covenants, conditions and undertakings hereinafter set forth, and for other good and valuable consideration, the receipt and sufficiency is hereby acknowledged, the Licensor and the Company agree as follows:

1. DEFINITIONS.

As used in this Agreement, the following capitalized terms, whether used in the singular or plural, shall have the following meanings:

(a) "Agreement" shall mean this Agreement, including all exhibits attached hereto together with any valid amendment to the foregoing.

(b) "Licensed Patent Rights" shall mean the rights to make, use, sell and otherwise employ the Valid Claims and other rights granted in or covered by all United States and foreign letters patent owned or acquired by the Licensor relating to the Technology, including but not limited to those listed on Exhibit A hereto, as well as any U.S. or foreign letters patent issued from any patent applications relating to the Technology, and all substitutions, continuations-in-part, divisions, reissues, re-examined patents, extensions and renewals of any of the foregoing.

(c) "Licensed Territory" shall mean every country in the world.

(d) "Net Sales" shall mean actual revenues received from the manufacture, use or sale of Products, less reductions for any sales.

and/or the Licensed Patent Rights as determined on a per Licensed Territory basis. All royalties due and payable hereunder shall be paid annually within thirty (30) days of December 31 of each year until such time as all patent expenses are repaid as provided in Section 3(d) of this Agreement. Thereafter, all such royalties shall be paid on a quarterly basis within thirty (30) days of the end of the applicable quarter.

(c) Records. The Company shall keep complete and accurate records and accounts of its sales of Products and sublicensing transactions in sufficient detail to enable royalties payable to be audited. The Licensor shall have the right to inspect the records on a quarterly basis during normal business hours and to appoint a certified accounting firm to audit the Company records. Such audit shall be at the sole expense of the Licensor. The accounting firm shall enter into a confidentiality agreement acceptable to the Company. All such information shall be deemed Confidential Information for all purposes of this Agreement. The Company shall preserve and maintain all records reasonably required for an audit hereunder for a period of five years. Notwithstanding the foregoing, the Company shall provide Licensor with a semi-annual report of all sales and sublicensing transactions involving the Products and Licensed Patent Rights during the term of this Agreement. Upon the commencement of quarterly royalty payments, such reports shall be provided on a quarterly basis.

(d) Patent Expenses. The Company shall be solely responsible for paying all legal expenses, including the filing fees, incurred in applying for, securing, prosecuting and maintaining patents or other intellectual property protection of the Technology on behalf of Licensor, whether in this or other countries. Company shall have sole discretion as to decisions to file or prosecute patent applications, to maintain issued patents and take other measures pursuant to this Section. The Company shall provide Licensor with estimates of major patent prosecution expenses and shall consult with Licensor regarding major prosecution decisions. For purposes of the foregoing, a major expense or decision shall be deemed to be any expense or decision that may result in an expense in excess of \$5,000.00. Notwithstanding the foregoing, Licensor shall reimburse Company for all such expenses incurred by the Company with respect solely to the initial United States application and any continuation or division of the initial U.S. application only as follows: Company may deduct such expenses from royalties payable by the Company to the Licensor, provided that Licensor shall not be obligated to pay such outstanding patent expenses in any calendar year in excess of that amount which equals fifteen percent (15%) of the total royalties payable to Licensor during that year. To the extent there are insufficient royalties in any calendar year to provide for payment of such expenses by Licensor in the manner set forth in this Section 3(d), Licensor's obligation to pay such expenses shall accrue and be applied to future royalty payments. To the extent the Company never pays sufficient royalties to allow

Exhibit C**ASSIGNMENT OF KNOW HOW**

WHEREAS, Richard Freer, a Virginia resident ("Freer"), and the chairman of the board of Discovery Group, L.C., as defined below, holds certain inventions, discoveries and know how relating to the design of a feedback device to effect automatic shutoff of a foot dorsiflexion device in the event of spontaneous spastic motion of the leg and foot (the "Freer Know How"), which Freer Know How is further defined by the block diagram attached at Exhibit A hereto.

WHEREAS, Lucian Y. Grove, Jr., a resident of Virginia ("Grove"), is the inventor and holder of know how relating to a pneumatic foot dorsiflexion device (the "Grove Know How") to which the Freer Know How may be applied in use and patented; and

WHEREAS, Discovery Group, L.C., a Virginia limited liability company of which Freer is a member ("Discovery Group"), is entering into an exclusive license agreement with Grove pursuant to which Freer is obligated to assign to Grove the Freer Know How, and Grove is obligated to license back to Discovery Group the combined Freer Know How and the Grove Know How in exchange for certain royalties on sales of products employing the Freer and Grove Know How (the "License Agreement"),

NOW, THEREFORE, contingent upon Grove fully and validly executing the License Agreement on or before May 17, 1997, and in consideration of the covenants exchanged in the License Agreement and recited herein, the receipt and sufficiency of which each party acknowledges, Grove and Freer do hereby agree as follows:

1. Freer represents that, to the best of his knowledge, he is authorized to grant the assignment made herein and that use of the Freer Know How as contemplated by this Agreement and the License Agreement will not infringe any third party rights. The parties acknowledge, however, that the patentability of the Freer Know How has not yet been determined. Freer therefore expressly disclaims any warranty of ownership, title, or noninfringement.

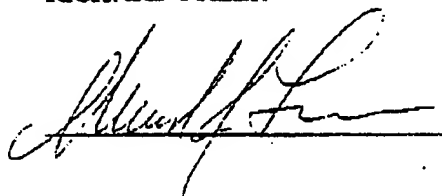
2. Freer does hereby sell, assign, transfer, and set over unto Grove, and Grove does hereby accept transfer and assignment, of all of Freer's right, title, and interest in and to the Freer Know How as well as any rights in any resulting patent application or letter patent, issued in any jurisdiction, the same to be held and enjoyed by Grove for his own use and behoof, and for the use and behoof of his heirs, executors, administrators, and assigns, for so long as legally-cognizable rights may subsist in the Freer Know How, including but not limited to the end of the full term for which any Letters Patent are granted.

3. Freer shall execute such additional documents as Grove may require and further provide Grove with reasonable cooperation and assistance in preparing and prosecuting any patent application for the combined Grove Know How and Freer Know How.

4. Grove acknowledges that Freer's grant of this Assignment is contingent upon Grove's execution of and performance of his obligations under the License Agreement, that this Assignment shall not take effect until Grove executes the License Agreement, and that this Assignment shall be null and void in the event Grove fails to execute the License Agreement. Discovery Group is a third party beneficiary of this Agreement.

IN WITNESS WHEREOF, the parties so agree.

RICHARD FREER



Acknowledgement

COMMONWEALTH OF VIRGINIA)

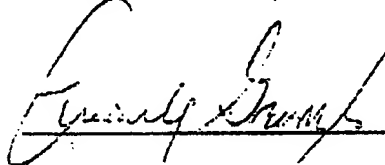
CITY/COUNTY OF Richmond) ss

On this 12 day of May 1997, before me appeared Richard Freer, the person who signed the foregoing instrument, who acknowledged that he or she signed it as a free act.

Paula H. Miller
Notary Public

My commission expires: 2/28/98

LUCIAN Y. GROVE, JR.



Acknowledgement

COMMONWEALTH OF VIRGINIA)

CITY/COUNTY OF Roanoke) ss

On this 15th day of May 1997, before me appeared Lucian Y. Grove, Jr., the person who signed the foregoing instrument, who acknowledged that he or she signed it as a free act.

Richard R. Seay
Notary Public

My commission expires: February 28, 1999